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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,934	10/19/2000	Henry Edward Pfeiffer	964-4	5671

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BLACKWELL SANDERS PEPER MARTIN LLP  
40 CORPORATE WOODS  
9401 INDIAN CREEK PARKWAY, SUITE 1200  
OVERLAND PARK, KS 66210-2020

EXAMINER

SAFAVI, MICHAEL

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 11/22/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/691,934

Applicant(s)

PFEIFFER, HENRY EDWARD

Examiner

M. Safavi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-16 and 39-46 is/are pending in the application.
- 4a) Of the above claim(s) 43-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-16 and 39-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 3-16 and 39-42 are, drawn to concrete form, classified in class 52, subclass 426.
  - II. Claim 43 is, drawn to building structure, classified in class 52, subclass 267.
  - III. Claims 44-46 are, drawn to method of construction, classified in class 264, subclass 33.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the claimed combination does not require a rectangular form segment nor a substantially planar tie having web and opposed flanges encapsulated within the panels. The subcombination has separate utility such as use as a building block per se without concrete or rebars.
3. Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product

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as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case claimed form can be used without stacking or as a building block per se.

4. Inventions III and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case claimed building structure can be made as by forming the concrete and rebar prior to stacking the forms.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Newly submitted claims 43-46 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: see above requirement for restriction. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 43-46 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 40 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear as to what is being defined by the language presented within claim 40. What, particularly, is being defined by “operable to permit the stacking of the foam blocks both upon and below adjacent blocks having a substantially identical configuration of teeth and sockets regardless of both vertical orientation and longitudinal orientation relative to longitudinal and vertical axes, respectively, of the foam blocks”? What, specifically, is being defined by “...regardless of both vertical orientation and longitudinal orientation...” or “...relative to longitudinal and vertical axes, respectively, of the foam blocks” or “...regardless of both vertical orientation and longitudinal orientation relative to longitudinal and vertical axes...”? There, otherwise, does not appear to be enough, if any, structure recited within the claim language to clearly set forth any limitation(s) which would serve to further narrow the claim or claims from which claim 40 depends. The metes and bounds of claim 40 can, therefore, not be ascertained.

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***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

9. Claims 3-16, 39, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Cymbala et al. '714. Cymbala et al. '714 shows, Figs. 1-3, pair of opposing foam panels 2 having a plurality of ties 3 extending therebetween with opposing flange members 4 embedded or encapsulated within respective opposing foam panels. A web 5 formed of spaced, parallel bridge members which possess outwardly extending rebar-retaining seats positioned therealong separates the opposing pair of flange members. Engaging means in the form of alternating teeth and sockets having substantially equal lateral dimensions is formed along the upper and lower edges as at 26, 27 which constitute "engaging means...for removably retaining a longitudinal edge having similar engaging means formed therealong". Second engaging means is formed along the side edges as at 20, 21. The second engaging means including an array of alternating teeth and sockets, (or tongues and grooves). Corner block can be seen in Fig. 4. A longitudinal

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axis of the tie flange members 4 can be seen as substantially equal in length to the transverse axis of the foam panels 2. Pair of parallel bridge members extending transverse to the flange members is as along 5. Rebar retaining seat can be seen formed along the bridge members.

10. Claims 3-16, 39, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Mensen '459. Mensen '459 shows, Figs. 1, 3, 4, 5, and 7, pair of opposing foam panels 12, 14 having a plurality of ties 42 extending therebetween with opposing flange members 44, 46 embedded or encapsulated within respective opposing foam panels. A web formed of spaced, parallel bridge members 48, 50 which possess outwardly extending rebar-retaining seats 76 positioned therealong separates the opposing pair of flange members. Engaging means in the form of alternating teeth and sockets having substantially equal lateral dimensions is formed along the upper and lower edges as described at lines 1-10 in col. 4 which constitute "engaging means...for removably retaining a longitudinal edge having similar engaging means formed therealong". Second engaging means is formed along the side edges as at 38 and can be seen in Fig. 1 along the side edges in the form of alternating teeth and socket, (or tongue and groove), formations. Corner block can be seen in Fig. 3. A longitudinal axis of the tie flange members 44, 46 can be seen as substantially equal in length to the transverse axis of the foam panels 12, 14. Pair of parallel bridge members extending transverse to the flange members is at 48, 50. Rebar retaining seat can be seen formed along the bridge members as within or between 76.

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11. Claims 3-5, 8-16, and 39-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Beliveau '462. Beliveau '462 shows, Figs. 1 and 3, pair of opposing foam panels 14a, 14b having a plurality of ties 16 extending therebetween with opposing flange members 20a, 20b embedded or encapsulated within respective opposing foam panels. A web 32 formed of spaced, parallel bridge members 44 which possess outwardly extending rebar-retaining seats positioned therealong separates the opposing pair of flange members. Engaging means in the form of alternating and substantially uniform teeth and sockets 18, 19 is formed along the upper and lower edges. Two rows of teeth can be seen with each tooth of a row being spaced apart from adjacent teeth of the same row by a socket with adjacent rows offset from each other by a distance of one side of one tooth. A longitudinal axis of the tie flange members 20a, 20b can be seen as substantially equal in length to the transverse axis of the foam panels 14a, 14b. Pair of parallel bridge members extending transverse to the flange members is as along 44. Rebar retaining seat can be seen formed along the bridge members.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.



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12. Claims 6, 39, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beliveau '462 in view of Horobin '382 or Mensen '459.

Each of Horobin '382 and Mensen '459 teach formation of engaging means in the form of alternating teeth and sockets, as at 20, 22 of Horobin '382 and 38 of Mensen '459, formed along the side edges of respective panel members. To have provided the Beliveau panel members with engaging means in the form of alternating teeth and sockets formed along the side edges, thus providing a more secure assembly of panel members in an edge to edge relationship, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by either of Horobin '382 or Mensen '459.

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beliveau '462 in view of either of Mensen '459 or Cymbala et al. '714.

Each of Mensen '459 and Cymbala '714 teach formation of a corner block concrete form including opposing foam panels having rectangular segments in angular relation to each other, Fig. 3 of Mensen '459 and Fig. 4 of Cymbala et al. '714. To have provided the Beliveau form assembly with any number of corner block concrete forms, thus allowing easy formation of a corner assembly, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by either of Mensen '459 or Cymbala et al. '714.

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*Response to Arguments*

14. Applicant's arguments filed September 12, 2002 have been fully considered but they are not persuasive. As for Applicant's argument to "means plus function", each of the applied prior art disclose "engaging means formed along the...longitudinal edges for removably retaining a longitudinal edge having similar engaging means formed therealong when adjacent thereto". The engaging means disclosed by each of Cymbala et al. '714, Mensen '459, and Beliveau '462 constitute equivalents of the engaging means disclosed within the instant specification with respect to the claimed limitation. Each of the engaging means of Cymbala et al. '714, Mensen '459, and Beliveau '462 are "for removably retaining a longitudinal edge having similar engaging means formed therealong when adjacent thereto" as is presented at lines 5-7 of instant claim 3. Applicant, otherwise, asserts further qualifications which do not appear to be established within the scope of the rejected claims.

With regard to Applicant's footnote 1, in light of Applicant's argument to "means plus function", the application of the three applied principal references is deemed appropriate. M.P.E.P. 706.02 does allow for utilization of various references when 1) the propriety of a 35 U.S.C. 102 or 103 rejection depends on a particular interpretation of the claim language. Such appears the situation with the present prosecution. Further, MPEP 904.03 does suggest utilization of a plurality of references when an applied reference has a publication date less than a year prior to the application filing date.

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As for Applicant's remark that "Examiner has failed to explain how Cymbala teaches...each of the elements set forth in [the] claims", the above rejections respectively set forth the elements of the rejected claims. To assist Applicant, Examiner has added language to the rejections pointing out elements presented within instant claims 10-13 which elements would otherwise be clearly ascertained by one having ordinary skill in the building form art. And, the language presented within each of claims 8, 9, and 14-16 appear as inherent features within the applied primary references.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

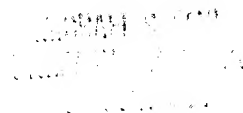
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2168.



M. Safavi  
November 20, 2002